

**Notice of Allowability**

Application No.

09/333,821

Examiner

CESAR B. PAULA

Applicant(s)

LEVINE ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the remarks filed on 2/26/07.
2. ☒ The allowed claim(s) is/are 1-8, and 10-33, renumbered as 1-32.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

**EXAMINER'S AMENDMENT/REASONS FOR ALLOWANCE**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The title has been amended as follows:

Please replace the entire title with the following: "SPECIAL API INTERFACE FOR INTERFACING AN APPLICATION WITH A TWAIN MODULE, NEGOTIATING AND PRESENTING A USER INTERFACE FOR INSERTING AN IMAGE INTO A DOCUMENT".

2. Authorization for the following examiner's amendment was given in a telephonic message from J. LaVar Oldham, Reg.# 53,409 on 5/9/2007:

**REPLACE THE ABSTRACT WITH THE FOLLOWING:**

Inserting images into documents. An image source device is made active with an application used to create text in a document. An application programming interface (API) module is accessed from within the application. The API interfaces the application with a TWAIN module used for acquiring an image with the image source device. The API module is separate from the TWAIN module and isolates users from directly interacting with the TWAIN module. The application uses the API module for negotiating with the image source device to determine a set of image capture parameters that control the image source device when acquiring the image. Data representing the image is communicated from the image source device into the memory

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of a computer hosting the application used to create text so that the data representing the image is a portion of a document stored in the memory.

### *Reasons for Allowance*

Regarding claims 1-8, and 10-33, the Examiner concurs with the Applicants' statement that the Sane reference does not teach or suggest the claimed invention, since "References may not be combined where references teach away from their combination. MPEP 2145(X)(D)(2). SANE, when viewed as a whole, including disclosure at <http://www.sane-project.org/intro.html> last paragraph seems to clearly indicate a clear case of teaching away from the combination of SANE with any TWAIN driver. Specifically, SANE teaches that "it is unlikely that there will ever be a SANE backend that can talk to a TWAIN driver." .....It would seem that the authors of SANE could clearly be classified as at least ordinarily skilled, and most likely extraordinarily skilled in the particular art in question. Yet, rather than using TWAIN drivers, the authors of SANE chose to rewrite entirely new drivers. See e.g. SANE at page marked 16 by the Examiner. Specifically, the authors of SANE note that "Agfa and Plustek scanner and Nikon filmscanner drivers are planned, and there is hope that drivers for some of the more popular digital cameras will materialize soon as well." Clearly the authors of SANE were familiar with TWAIN drivers as evidenced by the more than basic treatment of TWAIN at <http://www.sane-project.org/intro.html>. Yet rather than using existing TWAIN drivers, they chose to limit support only to those devices for which they had develop their own drivers and further warned others away from trying to combine a SANE backend with TWAIN drivers. It is clear that the authors of SANE not only do not provide motivation to combine software using TWAIN drivers with

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SANE, but clearly teach away from doing so.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)). The authors of SANE indicate that "any particular TWAIN driver is pretty much married to a particular GUI API" and "it is unlikely that there will ever be and SANE backend that can talk to a TWAIN driver." Clearly one of ordinary skill in the art, such as the authors of SANE likely are, would not be motivated to combine SANE, or any other similar technology with a TWAIN driver." (pages 15-16).

Furthermore, the subject matter discussed in the claims above are not shown nor would have been obvious to a person of ordinary skill in the art at the time of the invention was made in the prior art cited.

### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kester (Pat. # 6,003,093 A), Wang (Pat. # 6,286,054 B1), and Lavendel et al. (Pat. # 7,039,876 B2, and 6,587,129 B1).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 or 571 272-1000 (USA or Canada).

Any response to this Action should be mailed to:


Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

  
**CESAR PAULA**  
**PRIMARY EXAMINER**

5/10/2007